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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,248	03/16/2001	Kinam Park	368-011B	8278
7590	03/08/2006		EXAMINER	
Medicus Associates 2804 Kentucky Joplin, MO 64804			COONEY, JOHN M	
			ART UNIT	PAPER NUMBER
			1711	
DATE MAILED: 03/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/811,248

Applicant(s)

PARK ET AL.

Examiner

John m. Cooney

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 56-73 is/are pending in the application.
- 4a) Of the above claim(s) 64-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 56-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-13-05 has been entered.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 56-63 are rejected under 35 U.S.C. 102(a) as being anticipated by DE-195 40 951 (corresponding to USPAT 6,136,873)(Hereon referred to as HAHNLE et al.).

HAHNLE et al. disclose preparations of superabsorbent polymeric hydrogel composite materials prepared by combining under polymerization conditions ethylenically-unsaturated monomers, multi-olefinic crosslinking materials, and other additives and agents in amounts as claimed reading on the materials of applicants' claims (See HAHNLE et al. in its entirety). [ – Note also – the following cites from USPAT 6,136,873 {for informational purposes only} pertaining to English language

Art Unit: 1711

recitations of the later US equivalent – abstract, column 1 lines 12-16, column 2 line 24 et seq., column 3, column 5 line 26 et seq., column 6 lines 1-9, column 8 lines 49 et seq., column 9 lines 1-30, column 10-13, column 14 lines 1-6, and the examples - ]. Although pore size values, swelling ratio values, and compression values are not particularly disclosed by HAHNLE et al., it is held, given the make-ups and disclosed properties and behaviors of the materials disclosed, that these features of the claims are inherently possessed by the articles disclosed.

As the record currently stands, applicants' reference to the materials of their claims as being porous polymer networks is not distinguishing of the claims in a patentable sense. The materials employed in the making of the products of HAHNLE et al. and the process by which they are formed are such that the formation of a polymeric "network" to the degree defined by applicants' claims is held to be inherent to the teachings of HAHNLE et al.

Claims 56-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Phan et al.(5,506,035).

Van Phan et al. disclose preparations of superabsorbent crosslinked composite polymer network materials having pore sizes as claimed by applicants which are insoluble in water but swell to an equilibrium size in the presence of excess water {hydrogel} and are prepared by combining under polymerization conditions ethylenically-unsaturated monomers, multi-olefinic crosslinking materials, and other

Art Unit: 1711

additives and agents in amounts as claimed reading on the materials of applicants' claims (See the abstract, column 6 line 34 et seq., column 7, column 8 lines 1-53, and column 10 lines 35-60, as well as, the entire document). Although swelling ratio values, and compression values are not particularly disclosed by Van Phan et al., it is held, given the make-ups and disclosed properties and behaviors of the materials disclosed, that these features of the claims are inherently possessed by the articles disclosed.

As the record currently stands, applicants' reference to the materials of their claims as being porous polymer networks is not distinguishing of the claims in a patentable sense. The materials employed in the making of the products of Van Phan et al. and the process by which they are formed are so similar to the materials and processes of applicants' claims that the formation of a porous polymer "network" to the degree defined by applicants' claims is held to be inherent to the teachings of Van Phan et al.

Claims 56-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Park et al. (Society for Biomaterials article).

Park et al. discloses hydrogel foam compositions comprising polymerized networks of polymers prepared from ethylenically-unsaturated monomers and multiolefinic crosslinking agents (see the entire document). Although pore size values, swelling ratio values, and compression values are not particularly disclosed by Park et al., it is held, given the make-ups and disclosed properties and behaviors of the

Art Unit: 1711

materials disclosed, that these features of the claims are inherently possessed by the articles disclosed. Though amounts or proportions of monomer and crosslinking agent are not specified by Park et al. it is held that the widely encompassing range of values for this multifunctional co-reactant is readily envisaged from the teachings of the disclosed Park et al. reference.

Applicants' arguments pertaining to this rejection have been considered but rejection is maintained for all of the reasons set forth above. Examiner holds that the evidence of record based on the materials disclosed and their properties and behaviors supports the currently held position of anticipation as the reference discloses materials prepared from materials of applicants' claims and no differences in work-ups are seen which would lead to pore sizes outside of the encompassing range of values expressed by applicants' claims.

The points of law cited in applicants' most recent response relate to a different fact situation than that present in the instant case. Applicants have not demonstrated differences based on the materials employed in the making of the articles of their claims or based on the manner which they are prepared which serve to establish failure of the instantly held rejection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

Art Unit: 1711

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 56-63 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,750,585. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of 5,750,585 disclose crosslinked hydrogel matrix materials as claimed by applicants. Although overlap between the selections of functional species employed in the preparations of the claims of 5,750,585 and those of applicants' claims is not complete, operation within the disclosure of the claims of 5,750,585 for purposes of achieving acceptable results in order to arrive at the products of the instant claims would have been obvious to one having ordinary skill in the art in the absence of a showing of new or unexpected results attributable to the compositions as claimed by applicants. Differences in swelling and compression physical properties not recited in the claims of 5,750,585 are elements associated with the materials and manner of their preparation and distinction based on such is not seen to be evident.

Claims 56-63 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,960,617.

Art Unit: 1711


Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of 6,960,617 disclose crosslinked hydrogel matrix materials as claimed by applicants. Although overlap between the selections of functional species employed in the preparations of the claims of 6,960,617 and those of applicants' claims is not complete, operation within the disclosure of the claims of 6,960,617 for purposes of achieving acceptable results in order to arrive at the products of the instant claims would have been obvious to one having ordinary skill in the art in the absence of a showing of new or unexpected results attributable to the compositions as claimed by applicants. Differences in swelling and compression physical properties not recited in the claims of 6,960,617 are elements associated with the materials and manner of their preparation and distinction based on such is not seen to be evident.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Langer et al.(6,224,893) and Hahnle et al.(6,174,929) are cited for their disclosure of interesting materials in the related arts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JOHN M. COONEY, JR.  
PRIMARY EXAMINER  
Group 1700